

08-10-01

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PTO/SB/05 (12/97)
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 Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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UTILITY PATENT APPLICATION TRANSMITTAL

Attorney Docket No. **EMS-02-0164** Total Pages **14**

First Named Inventor or Application Identifier

Edward A. Jesser

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Express Mail Label No. **EL864504317 US**

APPLICATION ELEMENTS
 See MPEP chapter 600 concerning utility patent application contents.

ADDRESS TO: Assistant Commissioner for Patents
 Box Patent Application
 Washington, DC 20231

1. ☒ Fee Transmittal Form
 (Submit an original, and a duplicate for fee processing)
2. ☒ Specification [Total Pages **10**]
 (preferred arrangement set forth below)
 - Descriptive title of the invention
 - Cross References to Related Applications
 - Statement Regarding Fed sponsored R & D
 - Reference to Microfiche Appendix
 - Background of the Invention
 - Brief Summary of the Invention
 - Brief Description of the Drawings (if filed)
 - Detailed Description
 - Claim(s)
 - Abstract of the Disclosure
3. ☒ Drawing(s) (35 USC 113) [Total Sheets **4**]
4. Oath or Declaration [Total Pages **21**]
 - a. ☒ Newly executed (original or copy)
 - b. ☐ Copy from a prior application (37 CFR 1.63(d))
 (for continuation/divisional with Box 17 completed)
 (Note Box 5 below)
 - ☐ **DELETION OF INVENTOR(S)**
 Signed statement attached deleting
 inventor(s) named in the prior application,
 see 37 CFR 1.63(d)(2) and 1.33(b).
5. ☐ Incorporation By Reference (useable if Box 4b is checked)
 The entire disclosure of the prior application, from which a
 copy of the oath or declaration is supplied under Box 4b,
 is considered as being part of the disclosure of the
 accompanying application and is hereby incorporated by
 reference therein.

6. ☐ Microfiche Computer Program (Appendix)
7. Nucleotide and/or Amino Acid Sequence Submission
 (if applicable, all necessary)
 - a. ☐ Computer Readable Copy
 - b. ☐ Paper Copy (identical to computer copy)
 - c. ☐ Statement verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

8. ☐ Assignment Papers (cover sheet & document(s))
9. ☐ 37 CFR 3.73(b) Statement ☒ Power of Attorney
 (when there is an assignee)
10. ☐ English Translation Document (if applicable)
11. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
12. ☐ Preliminary Amendment
13. ☒ Return Receipt Postcard (MPEP 503)
 (Should be specifically itemized)
14. ☒ Small Entity Statement filed in prior application,
 Statement(s) ☐ Status still proper and desired
15. ☐ Certified Copy of Priority Document(s)
 (if foreign priority is claimed)
16. ☒ Other: **Check No. 33970 in the
 Amt. of \$ 355, Check No 33991
 in the amt. of \$ 130.00 - petition
 Fee, Certificate of mailing**

17. If a CONTINUING APPLICATION, check appropriate box and supply the requisite information:

☐ Continuation ☐ Divisional ☐ Continuation-in-part (CIP) of prior application No: _____
18. CORRESPONDENCE ADDRESS☐ Customer Number or Bar Code Labelor ☒ Correspondence address below

(Insert Customer No. or Attach bar code label here)

NAME	Ralph C. Francis (Reg. No. 38,884)			Francis Law Group	
ADDRESS	1808 Santa Clara Ave				
CITY	Alameda	STATE	CA	ZIP CODE	94501
COUNTRY	U. S. A.	TELEPHONE	(510) 769-9800	FAX	(510) 769-9804

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231

08/08/01

09/25/01

09/25/01

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FEE TRANSMITTAL
for FY 2001

Patent fees are subject to annual revision

TOTAL AMOUNT OF PAYMENT

(\$) 355

Complete if Known

Application Number	TBA
Filing Date	August 8, 2001
First Named Inventor	EDWARD A. JESSER
Examiner Name	TBA
Group Art Unit	TBA
Attorney Docket No.	EMS-02-0164

METHOD OF PAYMENT

- 1.
- ☒
- The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit
Account
Number

06-1830

Deposit
Account
Name

Francis LAW Group

- ☒
- Charge Any Additional Fee Required
-
- Under 37 CFR 1.16 and 1.17

☐ Applicant claims small entity status
See 37 CFR 1.27

- 2.
- ☒
- Payment Enclosed:

☒ Check ☐ Credit card ☐ Money
Order ☐ Other**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Small Entity

Fee Fee Fee Fee Fee Description

Code (\$)	Code (\$)	Code (\$)	Code (\$)	Code (\$)	Fee Description
101	710	201	355		Utility filing fee
106	320	206	160		Design filing fee
107	490	207	245		Plant filing fee
108	710	208	355		Reissue filing fee
114	150	214	75		Provisional filing fee

Fee Paid

355

SUBTOTAL (1) (\$) 355

2. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
12	-20** = 0	9	0
3	-3** = 0	40	0
Multiple Dependent			

Large Entity Small Entity

Fee Fee Fee Fee Fee Description

Code (\$)	Code (\$)	Code (\$)	Code (\$)	Code (\$)	Fee Description
103	18	203	9		Claims in excess of 20
102	80	202	40		Independent claims in excess of 3
104	270	204	135		Multiple dependent claim, if not paid
109	80	209	40		** Reissue independent claims over original patent
110	18	210	9		** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$) 0

**or number previously paid, if greater. For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity	Small Entity	Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for ex parte reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	390	216	195	Extension for reply within second month	
117	890	217	445	Extension for reply within third month	
118	1,390	218	695	Extension for reply within fourth month	
128	1,890	228	945	Extension for reply within fifth month	
119	310	219	155	Notice of Appeal	
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,240	241	620	Petition to revive - unintentional	
142	1,240	242	620	Utility issue fee (or reissue)	
143	440	243	220	Design issue fee	
144	600	244	300	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	710	246	355	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	710	249	355	For each additional invention to be examined (37 CFR § 1.129(b))	
179	710	279	355	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)

SUBMITTED BY

Name (Print/Type)

Ralph C. Francis

Registration No
(Attorney/Agent)

30,884

Complete (if applicable)

Telephone

(510) 769-9800

Signature

Date

8-8-01

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

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[illegible]

Danielle Gragg

Name of person mailing document

Name of person mailing document
Danielle Argy

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Edward A. JesserFOR: **RFID TAG ASSEMBLY
AND SYSTEM**SERIAL NO. **to be assigned**FILED: **to be assigned**ART UNIT NO: **to be assigned**EXAMINER: **to be assigned**Attorney Docket No: **EMS-02-016U**

the specification of which:

- (a) X is attached hereto
- (b) was filed on , as Application Serial No.
and was amended on
- (c) was described and claimed in International Application No.
filed on and as amended on

**STATEMENT OF FACTS IN SUPPORT OF FILING
ON BEHALF OF NONSIGNING INVENTOR (37 CFR 1.47)**

This statement is made as to the exact facts that are relied upon to establish the diligent effort made to secure the execution of the declaration by the nonsigning inventor for the above-identified patent application before deposit thereof in the U.S. Patent and Trademark Office.

 X Because signing on behalf of the nonsigning inventor is by a person or entity showing a sufficient proprietary interest, this statement also recites facts as to why this action was necessary to preserve the rights of the parties or to prevent irreparable change.

This statement is being made by the available person having first-hand knowledge of the facts recited therein.

A. Identification of Person Making Statement Of Facts

Mark Nicholson
160 Oak Creek Blvd
Scotts Valley, CA 95066

B. Last Known Address of the Nonsigning Inventor

Edward A. Jesser
20842 Nez Perce Trail
Los Gatos, CA 95030

C. Details of Refusal of Nonsigning Inventor to Sign Application Papers

1. On or about January 1, 2000, Edward A. Jesser ("Jesser") entered into a Consulting Agreement with Escort Memory Systems ("EMS") to perform certain prescribed services for EMS. Paragraph 6 of the Consulting Agreement provides:

All inventions, discoveries, concepts and ideas whether patentable or not, including all forms, such as: hardware, software, processes, methods, techniques as well as improvements thereto conceived (collectively referred as "Developments"), made, conceived or developed by Consultant and its agents, alone or with others, which (i) result from or relate to the Services; (ii) which Consultant or its agents may receive from the Company while performing the Service; or (iii) result from use of the Company's equipment, facilities or materials shall be property of the Company. Consultant hereby assigns his or her entire right, title and interest in and to all such Developments and any intellectual property rights arising therefrom and any Developments and related intellectual property resulting from the services performed by Consultant on behalf of the Company prior to the date hereof. Consultant shall further cooperate with the Company in connection with any applications, filings, or documents prepared and or filed related to the Developments. However, the Company shall have no rights to any products or information owned or developed by Consultant or its suppliers prior to August 1, 1999 or modifications to such products or information in in connection with the Project Assignment.

A copy of the Consulting Agreement is attached to the "Statement Establishing Proprietary Interest", filed concurrently herewith.

2. From May to July 2000, at the directive of EMS, Jesser conceived, developed and reduced to practice certain inventions related to RFID Tag Assemblies and Systems. The noted inventions are disclosed in Provisional Application S/N 60,224,932, which was filed on August 11, 2000 (i.e., the priority application).

3. In or about September 2000, the specification embodying the subject inventions was prepared and presented to Jesser for review. Upon receipt of Jesser's comments and recommended amendments to the specification, a final specification was prepared by EMS' attorneys.

4. In or about October, 2000, the revised specification, including claims and figures (i.e., Utility Application), was presented to Jesser. The Declaration and Assignment were also presented to Jesser for execution.

5. Notwithstanding the express terms of the Consulting Agreement, shortly after receipt of the noted documents, Jesser verbally refused to sign the Declaration and Assignment. Jesser contended that the inventions embodied in the specification were not subject to the Agreement. Jesser also demanded additional compensation for the Assignment of the inventions to EMS.

6. Since October 2000, EMS has attempted, and continues to attempt to resolve the instant matter. Indeed, notwithstanding the express terms of the Agreement on or about November 1, 2000, EMS offered Jesser additional compensation in the amount of \$2000 to execute the Declaration and a form Assignment. A counter-offer has yet to be offered by Jesser.

**D. Efforts During Convention Year to Prepare Application
and Obtain Inventor's Signature**

1. As indicated, within two (2) months of filing Provisional Application S/N 60/224,932 a Utility Application (specification, claims and figures) was prepared and presented to Jesser.

2. Although Jesser approved the application, submitted herewith, Jesser refused to sign the Declaration to effectuate the filing of the application.

3. As also indicated, since October 2000 EMS has attempted to negotiate mutually agreeable terms under which Jesser would agree to execute the Declaration.

**E. Proof of need to prevent irreparable damage or preserve
the rights of the parties**

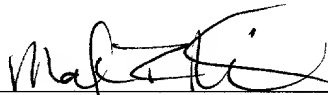
1. As indicated, the subject inventions are embodied in Provisional App'l S/N 60/224,432, which was filed on August 11, 2000. The statutory bar date to claim priority of the Application is thus August 10, 2001. Foreign filings based on the Provisional Application must also be effectuated on or before August 11, 2001.

2. EMS thus respectfully submits that a filing date for the Application submitted herewith is imperative to avoid the statutory bar and, hence, preserve its rights in and to the inventions embodied therein.

3. EMS has invested considerable time and resources developing and marketing the subject inventions and has developed a firm plan for commercialization. EMS will thus suffer irreparable damage if it is not accorded a filing date prior to the statutory bar dates.

4. EMS further submits that on or about 6.01.01, the Consulting Agreement was terminated by EMS. Although Jesser has not indicated such, EMS' attorneys have advised EMS that Jesser could assign (or license) the subject matter of the application to a competitor of EMS. Such an act would be extremely detrimental to EMS.

Date 8/7, 2001



Mark Nicholson
President - Escort Memory Systems

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:)

Edward A. Jesser)FOR: **RFID TAG ASSEMBLY**)
AND SYSTEM)SERIAL NO. **to be assigned**)FILED: **to be assigned**)ART UNIT NO: **to be assigned**)EXAMINER: **to be assigned**)Attorney Docket No: **EMS-02-016U**)

the specification of which:

- (a) X is attached hereto
- (b) was filed on , as Application Serial No.
and was amended on
- (c) was described and claimed in International Application No.
filed on and as amended on

**STATEMENT ESTABLISHING PROPRIETARY INTEREST BY
PERSON SIGNING ON BEHALF OF NONSIGNING INVENTOR**

I. I, Mark A. Nicholson, residing at 160 Oak Creek Blvd, Scotts Valley, CA 95066, am the person signing the Declaration on the above identified application on behalf of the nonsigning inventor and make this statement as to the facts establishing my proprietary interest.

II. As of the date I signed the Declaration for this application, the proprietary interest in this invention:

_____ belonged to me

X belonged to the following juristic person:

Escort Memory Systems
170 Technology Circle
Scotts Valley, California 95066

and I am authorized to sign the statement on behalf of the juristic person, my title being President.

III.

A. I establish the proprietary interest by

_____ attaching a copy of the assignment of this invention by the nonsigning inventor.

X attaching a copy of the agreement whereby the nonsigning inventor agreed to assign this invention.

Or

B. Although there is no assignment or written assignment to assign, a sufficient proprietary interest is demonstrated by the attached legal memorandum establishing that a court of competent jurisdiction would, by the weight of authority in that jurisdiction, award title in the invention to me or the legal entity on whose behalf I have authority to sign.

IV. Assignee's Statement

In accordance with 37 CFR 3.73, the assignee hereby states that the evidentiary documents with respect to its ownership have been reviewed and that, to the best of Assignee's knowledge and belief, title is in the Assignee seeking to take this action.

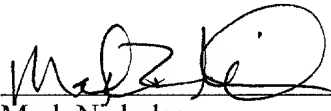
**V. Proof of Need to Prevent Irreparable Damage
or Preserve the Rights of the Parties**

1. As indicated in the "Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor, submitted herewith, the subject inventions are embodied in Provisional App'l S/N 60/224,432, which was filed on August 11, 2000. The statutory bar date to claim priority of the application is thus August 10, 2001. Foreign filings based on the application must also be effectuated on or before August 11, 2001.

2. EMS thus respectfully submits that a filing date for the application submitted herewith is imperative to avoid the statutory bar and, hence, preserve its rights in and to the inventions embodied therein.

3. EMS has invested considerable time and resources developing and marketing the subject inventions and has developed a firm plan for commercialization. EMS will thus suffer irreparable damage if it is not accorded a filing date prior to the statutory bar dates.

Date 8/7, 2001



Mark Nicholson
President - Escort Memory Systems